

DRAFT RESPONSE UNDER 37 C.F.R. § 1.111
Application No.: 09/840,269
Attorney Docket No.: Q64131

Group Art Unit No.: 2154

The ground of rejection and the discussion of Durrett remain similar to the August 19, 2005 Office Action. New to this Office Action, the Examiner responds to Applicants' arguments provided in the February 21, 2006 Amendment.

In that Amendment, Applicants noted that the Examiner alleges that the second claimed authentication can be mapped to the scenario where the user logged into the virtual disk server to retrieve the previously downloaded content object, wherein the authentication with the virtual disk server) uses the biometric feature. Applicants respectfully argued that this scenario argues against the current claims.

For example, claim 1 recites "performing a second comparison between third information associated with said second biometric feature obtained by the measurement and said first information." Applicants note that the first information is associated with the first biometric feature and the third information is associated with the second biometric feature. As such, the biometric feature obtained by the authentication at the delivery of contents is again used in the authentication at the reproduction of the contents. In this manner, in the present invention, transfer of registration information to the device that conducted the authentication at the delivery of content is avoided in the second instance. Under the Examiner's scenario, a comparison for the reproduction is again made with the virtual disk server. Accordingly, the claims are allowable at least for this feature.

In the present Office Action, the Examiner states that specifically, since claim 1, line 6 requires that the registered pattern be matched to the first measured biometric pattern, the two patterns are considered equivalent. As such, the Examiner alleges that it is an obvious option to

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use the first measured biometric pattern or the registered pattern as a reference in the second comparison, depending on where the comparison is performed.

Applicants respectfully traverse this assertion, and submit that it is based on improper hindsight in view of Applicants' own disclosure. In particular, the Examiner provides no motivation or rationale for equating the first measured biometric pattern with the "registered pattern." Further, the Examiner provides no reference where this would be taught or suggested. Indeed, the Examiner acknowledges that Durrett does not even teach a first authentication. Applicants respectfully remind the Examiner that the USPTO is held to a rigorous standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See, In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), citing, e.g., *In re Dembiczaik*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). In *Lee*, the Federal Circuit further emphasized that the "need for specificity pervades this authority." (*Lee* at 1433 (citing *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"))). The factual inquiry into whether to combine references "must be based on objective evidence of record." *Lee* at 1433. In this case, the Examiner has pointed to no teaching or motivation with respect to the comparisons and biometric features, but has simply

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stated that the two patterns are considered equivalent. This analysis and conclusion, however, fall well short of the particular findings required by *Lee*.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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